



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application: John Hathaway et al. Group Art Unit: 3727
Serial No.: 09/800,793 Examiner: Hylton, Robin A.
Filing Date: March 7, 2001 Docket No.: 18794-00044
Title: A CLOSURE HAVING AN ANNULAR SEALING BAND FOR PREVENTING
LEAKAGE DUE TO PART LINE FLASH OR SURFACE MISMATCH

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

REPLY BRIEF

Dear Sir:

This Reply Brief is in response to the Examiner's Answer filed March 24, 2005. As this Reply is being filed under a certificate of Express Mail dated May 24, 2005, no additional fees appear due. However, if any fees are required regarding the filing of this Reply, please charge such fees to our Deposit Account No. 13-0265.

Reply to Examiner's Answer

Appellants contend that combining the conventional closure with Williams, as proposed by the Examiner, is improper. Alternatively, Appellants contend that the combination of the conventional closure with Williams does not teach the claimed invention.

Improper Combination

There is no suggestion or motivation to combine a conventional closure with Williams. The conventional closure teaches and requires removing part-line flash from plastic closures by means of a secondary removal process. Because the part-line flash is removed, the conventional closure has an adequate seal. It is, therefore, unnecessary to combine it with another reference dealing with improving seals. Accordingly, one skilled in the art would have no motivation to combine the conventional closure with Williams.

Additionally, Williams does not suggest or teach part-line flash or surface mismatch. Williams only discloses adding an annular bead to overcome vacuum sealing problems associated with dimensional irregularities caused in manufacturing glass closures and glass jars, such as the glass closures being out-of-round. Glass closures are manufactured differently from plastic closures. Plastic closures are produced in dies, which is what causes the part-line flash and surface mismatch. Whereas, glass closures typically do not use dies, so no part-line flash or surface mismatch is created. Therefore, there is no suggestion or motivation to combine the conventional plastic closure with Williams.

Fails to Teach All Claimed Limitations

Even if one could assume that the combination is proper, the combination fails to teach all of Appellants' claimed limitations. Because the conventional closures remove part-line flash and/or surface mismatch and Williams does not have part line flash and/or surface mismatch, the resultant combination teaches a closure **without** any part line flash or surface mismatch. It does not teach a plastic closure with part-line flash or surface mismatch as required by Appellants' claims. Suggesting otherwise improperly adds the part-line flash or surface mismatch back. Clearly, therefore, the combination of the conventional closure with Williams fails to teach all of the Appellants' claimed limitations.

Response to Examiner's Argument

The Examiner argues that it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the teaching of at least one sealing band to the sealing surface of the conventional known closure disclosed by Appellants as taught by Williams. To support this conclusion the Examiner offers the following: "doing so would correct for defects of the closure and associated container opening to provide a more reliable seal without the necessity of removing the part line flash." While this statement may be true, it is nevertheless a conclusory statement. First, the Examiner does not properly identify the teaching, suggestion, or motivation found in either reference that leads one to combine the references. Second, the Examiner does not properly identify how the references teach using sealing bands on sealing surfaces of plastic closures to overcome removing part line flash.

The Examiner states that the factual evidence to support this rejection lies in the teachings of the conventional closure having a part line flash and the closure of Williams. The Examiner, however, has failed to identify the factual evidence or where it can specifically be found. Failing to do so precludes the Appellants an opportunity to respond properly.

Further, the Examiner argues that Appellants' statement that the conventional closure and Williams do not teach all of the claimed limitations is erroneous. However, in contravention to MPEP §1208, the Examiner fails to point out where each of the specific limitations recited in the rejected claims is found in the prior art. Further, because the Examiner's rejection is based upon a combination of references, the Examiner must explain the rationale for making the combination. This rationale must consist of more than "the sealing bead is effective in negating the additional manufacturing step of removing the part line flash," which is Appellants invention.

Finally, the Examiner offers U.S. Patent No. 5,320,236 to Gregory as further evidence of using a bead to engage a gasket for an effective sealing engagement between a closure and an associated container. Appellants must assume that the Examiner cited this new reference, which was not cited previously, as evidence of the prior well known statement made by the Examiner. The Examiner states that Gregory provides support for "using a bead to engage a gasket for an effective sealing engagement between a closure and an associated container." Gregory provides no such support. Gregory discloses, as does the conventional closure, performing an additional manufacturing process to trim off material from the sealing surface of the container, see column 2, lines 35-38. Additionally, Gregory discloses an annular flange that engages the **top** surface of the

plastic container 12, not the sealing surfaces of the closure as required by Appellants' claims. Appellants, therefore, are unsure as to why the Examiner cited this reference.

In light of the foregoing, Appellants contend that the Examiner's rejection of claims 3 through 14 under 35 U.S.C. §103(a) is improper, and that claims 3 through 14 are in condition for allowance. Therefore, Appellants respectfully request the present application be remanded to the Examiner for allowance of claims 3 through 14.

Respectfully submitted,

Date: May 24, 2005

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1. Reply Brief